



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,053	06/21/2000	Rodric C Fan	M-9199US	6523

24251 7590 09/19/2002

SKJERVEN MORRILL LLP
25 METRO DRIVE
SUITE 700
SAN JOSE, CA 95110

EXAMINER

ISSING, GREGORY C

ART UNIT PAPER NUMBER

3662

DATE MAILED: 09/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/599,053

Applicant(s)

FAN ET AL.

Examiner

Gregory C. Issing

Art Unit

3662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13. 6) ☐ Other: _____

Art Unit: 3662

Claim Objections

1. Claim 49 is objected to because of the following informalities: in claim 49, “communication” should be “communication”. Appropriate correction is required.
2. The drawings are objected to because in Figure 2 box 202, “quarry” should be “query”.
A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 42, 43, 60 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 42/60, the language “receiving the location of the first mobile unit as an authentication for the request” is not understood. Likewise, the language of claim 43/61, “receiving the location of the first mobile unit from the second mobile unit as an authentication or the request” is not understood.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3662

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 37-40, 44, 49, 51, 52, 56, 57, 62, 67 and 69 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Newman.

Newman disclose a method and apparatus for receiving data 110 comprising a location of a first mobile device 100, storing the location of the first mobile device 118, receiving a request from a user 128 for information regarding the device 100 and accessing and communicating 120 the information to the user 128.

7. Claims 37-69 are rejected under 35 U.S.C. 102(a) as being anticipated by Dussell et al.

Dussell et al disclose a central server (geocoded database, possibly maintained on home computer system) which is provided with GPS data from a plurality of vehicles housing mobile computers and stores the GPS data in a file. Additionally, a mobile computer can address a data request to the server which then packages the requested data in a packet and sends the packaged data to the requesting device. This approach allows a client to request and promptly receive GPS data and non-GPS data, allows the data to be requested only when it is needed. The location determining means reads on the first platform, the mobile computer reads on the second platform and the database reads on the server. The database 10 may be an Internet Web Page including

Art Unit: 3662

geocoded references for a variety of business establishments and other locations and is accessible by calendaring, scheduling and/or other application programs running on the mobile computer.

8. Claims 37-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Girerd et al.

Girerd et al disclose the claimed method and system for providing location-relevant information including a server 10 receiving location information from a sensor 20 and storing the location information thereat as well as a client 1 that requests information from the server 10 about the sensor 20. In response to the request from the client, the server provides the client with a report that may superimpose the sensor's location on a map or other reference.

The applicants argue that Girerd et al fail to teach "receiving a request from a user", "accessing the requested information based on the stored location" or "transmitting the requested information to a second mobile unit" with the underlined material emphasized by the applicants. Each of these features is disclosed by Girerd et al contrary to the applicants' allegation. A user, i.e. the client, uses a browser to access, process and display Web documents from the server after providing user identification as well as sensor identification therefore meeting the limitation of receiving a request from a user. The report provided to the user from the server may be a sensor location superimposed on a map or other reference wherein the server has an GIS application thereat for providing such information and therefore meeting the limitation of accessing the requested information based on the stored location. Lastly, the sensor data and GIS information is downloaded to the user and therefore meets the limitation of the transmission of the requested information. Thus, the applicants' arguments are contrary to the teachings of the reference and are not persuasive.

9. Claims 37-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Berstis.

Berstis discloses in Figure 5 a server 40 that receives location information from GPS receiver 45 attached to the vehicle, receives requests for information regarding the location from a user of a palmtop computer 12, accesses various content-rich information on the basis of the location and downloads the information to the palmtop computer. The storage of the location of the receiver 45 at the server 40 is inherent in view of the fact that the location is required to retrieve information from various web pages/applications as well as the fact that Berstis suggests the use of the location monitoring for billing purposes. For billing purposes, the location information would be required to be stored in order to associate billing rates attributed to the various regions.

The applicants argue that Berstis fails teach “receiving a request from a user”, “accessing the requested information based on the stored location” or “transmitting the requested information to a second mobile unit” with the underlined material emphasized by the applicants. These alleged distinctions are contrary to the teachings of Berstis since the client PDA 12 has input means for accessing a browser for communication with the server via a wireless link transceiver 58. A map of the desired route may be requested and provided to the client PDA. Additionally, Berstis defines the client as anyone who requests or gets the file. Upon the request of a map, the server and/or its application servers access various databases to provide the maps/landmarks/photographs etc. Subsequently, this information is downloaded to the client PDA. Thus, the applicants’ arguments are contrary to the teachings of Berstis.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McDonough et al disclose a GPS receiver cradle in a vehicle which may be used to hold a hand-held computer; the hand-held computer is connected via the Internet to a home page

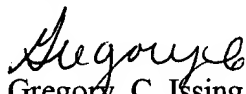
Art Unit: 3662

having links to various databases for retrieval of information. Semple et al disclose a method for locating items of interest including selecting a first location from a second location device and retrieving information about the first location via a database and subsequently communicating the information about the first location to the second location device. Blumberg et al disclose a system and method for accessing information about a first location by requesting information from a server at a second location device; based on GPS position data, real estate information is downloaded from a database.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (703)-306-4156. The examiner can normally be reached on Mon-Thurs 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (703)-306-4171. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Gregory C. Issing
Primary Examiner
Art Unit 3662



gci
September 16, 2002